

1 REMARKS

2 Status of the Claims

3 Claims 1 - 8 and 10 - 33 remain pending in the present application. No amendment has been
4 made in this response, and the claims are listed above solely for the convenience of the Examiner.

5 Claims Rejected Under USC § 103(a)

6 The Examiner has rejected independent Claims 1, 3, 15-16, 24-25, 27-28, and 29-31 under
7 35 USC § 103(a) as being obvious in view of Corel WordPerfect 6.1, 1996, in view of "Twain White
8 Paper," (<http://www.twain.org>) 1996, pages 1-4, (herein referred to as "the TWAIN reference").
9 Claims 2, 6, 10, 12, and 17 were rejected under 35 USC § 103(a) as being obvious over Corel
10 WordPerfect 6.1, 1996 in view of the TWAIN reference, and in further view of "Ulead PhotoImpact
11 3.0" User Guide for Windows 95 and Windows NT 3.51, 1996, pp. 104-107, 111-114, and 162-167
12 (hereinafter, "Photoimpact"). Claims 4-5, 18, 21-23, and 32-33 were rejected under 35 USC § 103(a)
13 as being obvious over Corel WordPerfect 6.1, 1996, in view of the TWAIN reference and in further
14 view of US Patent No. 5,907,665 to Sobol et al. (hereinafter, "Sobol"). Claims 7-8, 11, 13, 14, 19,
15 20, 26, and 31 were rejected under 35 USC § 103(a) as being obvious over Corel WordPerfect 6.1,
16 1996 (hereinafter, "WordPerfect"), in view of the TWAIN reference and further in view of one or
17 more of the following: "Mastering Photoshop 5 for the Web," 1998, pp. 1-10, "Troubleshooting and
18 configuring the Windows NT/95 Registry," Clayton Johnson, 1997, pp. 1-2, TWAIN specification
19 version 1.8, 10/22/98, US Patent No. 5,845,076 to Arakawa, Sobol, and US Patent No. 6,154,756 to
20 Hearn. Applicants respectfully disagree that the references disclose all of the steps or elements of the
21 claim recitation for at least the reasons set forth below.

22 In the interest of reducing the complexity of the issues for the Examiner to consider in this
23 response, the following discussion focuses on independent Claims 1, 18, and 24. The patentability of
24 each remaining dependent claim is not necessarily separately addressed in detail. However,
25 applicants' decision not to discuss the differences between the cited art and each dependent claim
26 should not be considered as an admission that applicants concur with the Examiner's conclusion that
27 these dependent claims are not patentable over the disclosure in the cited references. Similarly,
28 applicants' decision not to discuss differences between the prior art and every claim element, or every
29 comment made by the Examiner, should not be considered as an admission that applicants concur
30 with the Examiner's interpretation and assertions regarding those claims. Indeed, applicants believe

1 that all of the dependent claims are patentable over the cited references. Moreover, a specific
2 traverse of the rejection of each dependent claim is not required, since dependent claims are
3 patentable for at least the same reasons as the independent claims from which the dependent claims
4 ultimately depend.

5 Applicants respectfully submit that the Examiner's rejection of Claims 1, 18, and 24 is based
6 on a fundamental misunderstanding of applicants' recitation embodied in these independent claims.
7 The Examiner first asserts that "TWAIN discloses a SAPI – a special application programming
8 interface (API) module - that allows a user's selection to trigger negotiated settings by a negotiation
9 process between an application -- causing the application program to negotiate --, describing the data
10 it wants, and a source device, defining the data it can provide." The Examiner then further asserts
11 that "the SAPI interface allows the application to acquire an image through a 'Source Manager'
12 which contacts a 'Source Driver'-TWAIN module-- which represents the hardware device used to
13 acquire the image." However, this teaching of the cited reference bears little relation to applicants'
14 claim recitation in Claims 1, 18, and 24. In fact, the Examiner is simply reiterating the function of a
15 TWAIN interface, as described by the TWAIN reference. Contrary to the Examiner's assertion, the
16 cited reference does not teach that a SAPI within the TWAIN module functions in the manner recited
17 by applicants' claims. Applicants respectfully direct Examiner's attention to page 2, paragraph 4 of
18 the TWAIN reference, which is directed to disclosing the origin of the TWAIN *standard*, and which
19 reads in part "a composite of Silicon Beach/Adobe plug-ins, an internal Aldus protocol, an HP
20 protocol under development and *Logitech's SAPI* was used as the *basis* for TWAIN." (Emphasis
21 added.) It is clear from this excerpt of the TWAIN reference, that the TWAIN *standard* was
22 developed *based on* several discrete components, including Logitech's SAPI. However, contrary to
23 the Examiner's statement, there is no teaching or suggestion in the cited TWAIN reference that "a
24 special application programming interface (API) *module* accessed from within the application
25 program" *interfaces with* a Twain module, and no teaching or suggestion of any functions that such
26 an API might perform. The cited reference therefore does not teach or suggest using a special
27 application programming interface, and the recitation of applicants' claims regarding the special
28 application programming interface module is thus directed to a novel and non-obvious step/element,
29 since it is not disclosed or suggested by the cited art.

1 Furthermore, *arguendo*, even if the TWAIN module included an API, which is never
2 explicitly disclosed or suggested by the TWAIN reference, applicants' Claim 1 further recites that the
3 special application programming interface module *interfaces with* the TWAIN module. Assuming
4 that the TWAIN module indeed includes an SAPI, nothing in the cited references teaches or suggests
5 an SAPI that *interfaces with* a TWAIN module. The Examiner further misconstrues the TWAIN
6 reference to read on applicants' recited claims when asserting that "[t]he application has to go
7 through the SAPI, and the 'Source Manager' in order to access the 'Source driver', thereby isolating
8 the user of the application from the driver of the acquisition device." In fact, the Examiner has
9 simply quoted a portion of the TWAIN reference's description of the architecture of the TWAIN
10 module and then added an assertion that "[t]he application has to go through the SAPI, and the
11 'Source Manager' in order to access the 'Source driver'." But, there is no support for the Examiner's
12 assertion in the art cited.

13 It appears that the Examiner has used applicants' own claim recitation as a map in order to
14 assemble discrete words that appear in applicants' claims, including the term "SAPI," even though
15 these words are used out of context in the Examiner's argument, compared to their use in the TWAIN
16 reference, in order to support the assertion that the TWAIN reference teaches what is recited by
17 applicants' Claims 1, 18, and 24. Such a basis for rejecting these claims is not permissible. Without
18 any context in the cited art for teaching or suggesting to one of ordinary skill in the art the elements
19 of applicants' claim recitation, and teaching or suggesting how the proposed combination of cited
20 references might achieve the recited claim language of applicants, the Examiner is not permitted to
21 reject applicants' claims. It is not sufficient for the Examiner to simply assert that "[i]t would have
22 been obvious to a person of ordinary skill in the art at the time of the invention to have combined the
23 teachings of WordPerfect, and TWAIN, and access the SAPI from within the application to
24 communicate or interact with the driver, because Wordperfect (*sic*) discloses the acquisition of
25 images from a scanner directly from the user using TWAIN." Indeed, in making the last statement
26 (i.e., "directly from the user using TWAIN"), it appears the Examiner recognizes that the TWAIN
27 interface *alone* is described by the prior art as the only item used for initiating image acquisition. In
28 contrast, applicants' claims recite that a special application programming interface (API) module
29 accessed from within the application program is used for interfacing the application program with a
30 TWAIN module. The Examiner has failed to present a *prima facie* case of obviousness, and further

1 presents no colorable or reasonable motivation whatsoever to combine the references as proposed.
2 Furthermore, none of the cited references, individually or read together actually teach or suggest an
3 SAPI *that interfaces* with a TWAIN *module*. For these reasons alone applicants assert that
4 Claims 1, 18, and 24, as well as the claims that depend from them, are all allowable over the cited art
5 and respectfully request that the rejections be withdrawn.

6 In addition to the above reasons for allowability, applicants further note that in contrast to the
7 recitation of applicants' Claims 1, 18, and 24, the prior art fails to teach or suggest any use of a
8 special API module having the *functionality* corresponding to that recited in these independent
9 claims. As previously pointed out to the Examiner, there is no teaching or suggestion in the
10 WordPerfect reference of *how* the alleged direct scanning of an image into a WordPerfect document
11 is carried out, and no teaching or suggestion that would lead one of ordinary skill in the art to
12 understand that it was done without directly interfacing the application with the TWAIN API
13 modules. Applicants have previously explained at length how the prior art approach for scanning
14 images is implemented and have contrasted this conventional approach with the novel technique that
15 is used in their invention. To simplify the acquisition of images from within a software application,
16 applicants created the special API module, which serves as *an interface* between a software
17 application and the TWAIN module that actually interacts with an active image scanning device, to
18 scan an image.

19 None of the cited art mentions the use of a special API module like that recited in applicants'
20 Claims 1, 18, and 24. Furthermore, there is no disclosure or suggestion of how the *functionality*
21 provided by this module can be achieved in either the WordPerfect or TWAIN references. Clearly,
22 the functions achieved by applicants' recited special API module are not included in the WordPerfect
23 or TWAIN references, and the Examiner has relied upon an assertion that it would be obvious to
24 combine the WordPerfect and TWAIN references to provide these functions without providing any
25 clear evidence supporting that assertion. Accordingly, it is not clear how such a combination would
26 be achieved, since there is no enabling disclosure in any of these references that would lead one of
27 ordinary skill in the art to modify WordPerfect or TWAIN to arrive at such functionality.

28 Based upon the comments made above, it should be evident that all claims in the present
29 application are patentable. Accordingly, the application should be passed to issue without further
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1 delay. If any issues remain, the Examiner is invited to telephone applicants' attorney at the number
2 listed below.

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4 Respectfully submitted,

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6

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10 MAILING CERTIFICATE

11 I hereby certify that this correspondence is being deposited with the U.S. Postal Service in a sealed
12 envelope as first class mail with postage thereon fully prepaid addressed to: Commissioner for Patents,
Alexandria, VA 22313-1450, on October 14, 2005.

13 Date: October 14, 2005

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